REMARKS

Claims 1-19 are pending in the Application. Claims 1-19 are rejected under 35 U.S.C. §103(a). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request that the Examiner reconsider and withdraw these rejections.

I.   REJECTIONS UNDER 35 U.S.C. §103(a):

A.   Claims 1, 7, 13-14 and 19 are improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Midgley in view of Maffezzoni.

The Examiner has rejected claims 1, 7, 13-14 and 19 under 35 U.S.C. §103(a) as being unpatentable over Midgley et al. (U.S. Patent No. 6,625,623) (hereinafter "Midgley") in view of Maffezzoni (U.S. Patent No. 6,385,707). Applicants respectfully traverse and respectfully request the Examiner to reconsider and withdraw these rejections.

1.   Midgley and Maffezzoni, taken singly or in combination, do not teach or suggest the following claim limitations.

Regarding claims 1 and 7, Applicants respectfully assert that Midgley and Maffezzoni, taken singly or in combination, do not teach or suggest "storing backup files in a locked partition of a storage device." The Examiner cites column 2, lines 30-35 of Midgley as teaching storing backup files. Office Action (5/3/2006), page 2. The Examiner further cites column 3, lines 20-23 of Maffezzoni as teaching a locked partition of a storage device. Office Action (5/3/2006), page 3. Applicants respectfully traverse.

Maffezzoni instead teaches selecting files to be copied from the primary drive of the computer system to the backup drive. Column 3, lines 5-7. Maffezzoni further teaches that the copying of the selected files. Column 3, line 10. Maffezzoni further teaches generating a list of non-copied files that are locked by an operating system running on the primary drive. Column 3, lines 11-13. Maffezzoni further teaches copying the files identified in the list of non-copied files from the primary drive to the backup drive in order to make the backup drive a fully bootable drive. Column 3, lines 16-20. Maffezzoni further teaches a system for copying locked system files from a first drive of a computer to a second drive. Column 3, lines 21-23. Hence,

Maffezzoni teaches locking non-copied files by an operating system running on the primary drive and then later copying these files to the backup drive. There is no language in the cited passage that teaches a <u>locked partition</u> of a <u>storage device</u>. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1 and 7, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Furthermore, regarding claims 1, 7, 13 and 19, Applicants respectfully assert that Midgley and Maffezzoni, taken singly or in combination, do not teach or suggest "reading other partitions of said storage device to determine which files have been modified since most recent backup operation." The Examiner cites column 2, lines 20-30 Midgley as teaching the above-cited claim limitation. Office Action (5/3/2006), page 2. Applicants respectfully traverse and assert that Midgley instead teaches that the synchronization replication process builds a baseline data structure of target data files. Column 2, lines 19-20. Midgley further teaches that in parallel to this synchronization process, the system includes a dynamic replication process that includes a plurality of agents, each of which monitors file access operations for a server on the network to detect and capture, at the byte-level, changes to the source data files. Column 2, lines 20-25. Midgley further teaches that each agent may record the changes to a respective journal file, and as the dynamic replication process detects that the journal files contain data, the journal files are transferred or copied to the back up server so that the captured changes can be written to the appropriate ones of the target data files. Column 2, lines 25-30. Hence, Midgley teaches using agents to monitor changes to the source data files and to record such changes to a journal file. There is no language in the cited passage that teaches reading other partitions of a storage device. Neither is there any language in the cited passage that teaches reading other partitions of a storage device to determine which files have been modified since most recent backup operation. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 7, 13 and 19, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Additionally, regarding claims 1, 7, 13 and 19, Applicants respectfully assert that Midgley and Maffezzoni, taken singly or in combination, do not teach or suggest "running a virus scan on files determined to be modified." The Examiner cites column 12, lines 39-43 of Maffezzoni as teaching the above-cited claim limitation. Office Action (5/3/2006), page 3. Applicants respectfully traverse and assert that Maffezzoni instead teaches that the backup restore engine is charged with performing virus checking on all files before the copying is performed. Column 12, lines 39-41. There is no language in the cited passage that teaches running a virus scan on <u>files determined to be modified</u>. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 7, 13 and 19, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Furthermore, regarding claims 1, 7, 13 and 19, Applicants respectfully assert that Midgley and Maffezzoni, taken singly or in combination, do not teach or suggest "copying uncorrupted modified files." The Examiner cites column 2, lines 15-30 of Midgley as teaching the above-cited claim limitation. Office Action (5/3/2006), page 3. Applicants respectfully traverse and assert that Midgley instead teaches a synchronization replication process that replicates selected source data files data stored on the network to create a corresponding set of replicated data files, called the target data files, that are stored on a back up server. Column 2, lines 15-19. Midgley further teaches that the synchronization replication process builds a baseline data structure of target data files. Column 2, lines 19-20. Midgley further teaches that in parallel to this synchronization process, the system includes a dynamic replication process that includes a plurality of agents, each of which monitors file access operations for a server on the network to detect and capture, at the byte-level, changes to the source data files. Column 2, lines 20-25. Midgley further teaches that each agent may record the changes to a respective journal file, and as the dynamic replication process detects that the journal files contain data, the journal files are transferred or copied to the back up server so that the captured changes can be written to the appropriate ones of the target data files. Column 2, lines 25-30. Hence, Midgley teaches using agents to monitor changes to the source data files and to record such changes to a journal file. There is no language in the cited passage that teaches

copying <u>uncorrupted modified files</u>. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 7, 13 and 19, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Additionally, regarding claims 1, 7, 13 and 19, Applicants respectfully assert that Midgley and Maffezzoni, taken singly or in combination, do not teach or suggest "replacing backup files in said locked partition of said storage device that have been modified since most recent backup operation with said uncorrupted modified files." The Examiner cites column 2, lines 15-30 of Midgley as teaching the above-cited claim limitation. Office Action (5/3/2006), page 3. Applicants respectfully traverse.

As stated above, Midgley instead teaches a synchronization replication process that replicates selected source data files data stored on the network to create a corresponding set of replicated data files, called the target data files, that are stored on a back up server. Column 2, lines 15-19. Midgley further teaches that the synchronization replication process builds a baseline data structure of target data files. Column 2, lines 19-20. Midgley further teaches that in parallel to this synchronization process, the system includes a dynamic replication process that includes a plurality of agents, each of which monitors file access operations for a server on the network to detect and capture, at the byte-level, changes to the source data files. Column 2, lines 20-25. Midgley further teaches that each agent may record the changes to a respective journal file, and as the dynamic replication process detects that the journal files contain data, the journal files are transferred or copied to the back up server so that the captured changes can be written to the appropriate ones of the target data files. Column 2, lines 25-30. Hence, Midgley teaches using agents to monitor changes to the source data files and to record such changes to a journal file.

There is no language in the cited passage that teaches replacing backup files in the locked partition of the storage device. Neither is there any language in the cited passage that teaches replacing backup files in the locked partition of the storage device that have been modified. Neither is there any language in the cited passage that teaches replacing backup files in the locked partition of the storage device that

have been modified since most recent backup operation with the uncorrupted modified files. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 7, 13 and 19, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Regarding claim 13, Applicants respectfully assert that Midgley and Maffezzoni, taken singly or in combination, do not teach or suggest "a storage medium coupled to said processor, wherein said storage medium comprises a locked partition configured to store a second operating system and backup files, wherein said locked partition is accessed only by the second operating system." The Examiner has not addressed this claim limitation. The Examiner is reminded that, in order to establish a *prima facie* case of obviousness, the Examiner must provide a reference or combination of references that teaches all of the claim limitations. M.P.E.P. §2143. Since the Examiner has not provided such a reference, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 13. M.P.E.P. §2143.

Furthermore, regarding claim 13, Applicants respectfully assert that Midgley and Maffezzoni, taken singly or in combination, do not teach or suggest "a memory unit coupled to said processor, wherein said memory unit is operable for storing a computer program for restoring previously un-backed up data during a system restore." The Examiner has not addressed this claim limitation. The Examiner is reminded that, in order to establish a *prima facie* case of obviousness, the Examiner must provide a reference or combination of references that teaches all of the claim limitations. M.P.E.P. §2143. Since the Examiner has not provided such a reference, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 13. M.P.E.P. §2143.

Regarding claim 19, Applicants respectfully assert that Midgley and Maffezzoni, taken singly or in combination, do not teach or suggest "a memory unit coupled to said processor, wherein said memory unit is operable for storing a computer program for restoring previously un-backed up data during a system restore." The Examiner cites column 8, lines 15-25 and 50-60 of Midgley as teaching the above-cited claim limitation. Office Action (5/3/2006), page 6. Applicants

respectfully traverse and assert that Midgley instead teaches conventional network elements and nodes such as client stations, work stations, printers, hubs, routers, and other conventional data network equipment. Column 8, lines 14-17. Midgley further teaches that the data may be physically stored on any suitable memory system including a cache memory system, a random access data memory, or a persistent data memory. Column 8, lines 52-55. There is no language in the cited passages that teaches a memory unit coupled to the processor, where the memory unit is operable for storing a computer program for restoring previously un-backed up data during a system restore. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 19, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Furthermore, regarding claim 19, Applicants respectfully assert that Midgley and Maffezzoni, taken singly or in combination, do not teach or suggest "a storage medium coupled to said first computing system, wherein said storage medium comprises a locked partition configured to store a second operating system and backup files, wherein said locked partition is accessed only by said second operating system." The Examiner cites column 3, lines 20-23 of Maffezzoni as teaching the aspect of a locked partition. Office Action (5/3/2006), page 5. The Examiner further cites column 2, lines 32-35 and column 8, lines 40-50 of Midgley as teaching the remaining elements of the above-cited claim limitations. Office Action (5/3/2006), pages 6-7. Applicants respectfully traverse.

Maffezzoni instead teaches selecting files to be copied from the primary drive of the computer system to the backup drive. Column 3, lines 5-7. Maffezzoni further teaches that the copying of the selected files. Column 3, line 10. Maffezzoni further teaches generating a list of non-copied files that are locked by an operating system running on the primary drive. Column 3, lines 11-13. Maffezzoni further teaches copying the files identified in the list of non-copied files from the primary drive to the backup drive in order to make the backup drive a fully bootable drive. Column 3, lines 16-20. Maffezzoni further teaches a system for copying locked system files from a first drive of a computer to a second drive. Column 3, lines 21-23. Hence,

Maffezzoni teaches locking non-copied files by an operating system running on the primary drive and then later copying these files to the backup drive. There is no language in the cited passage that teaches a <u>locked partition</u> of a <u>storage medium</u>. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 19, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Further, Midgley instead teaches a system for creating backup files for data files stored on a computer network. Column 3, lines 32-34. Midgley further teaches that such a system comprises a backup server that has storage for a plurality of data files. Column 3, lines 34-35. Midgley further teaches that the backup systems will operate with data storage devices that store different formats of data and different types of files. Column 8, lines 43-45. There is no language in the cited passages that teaches a storage medium coupled to said first computing system, where the storage medium stores a <u>second operating system and backup files</u>. Neither do the cited passages teach that the area of the storage medium that stores a second operating system and backup files <u>is accessed only by the second operating system</u>. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 19, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Claim 14 recites combinations of features of independent claim 13 and hence claim 14 is patentable over Midgley in view of Maffezzoni for at least the reasons that claim 13 is patentable over Midgley in view of Maffezzoni.

As a result of the foregoing, Applicants respectfully assert that there are numerous claim limitations not taught or suggested in Midgley in view of Maffezzoni, and thus the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 1, 7, 13-14 and 19. M.P.E.P. §2143.

2.   <u>Examiner's motivation for modifying Midgley with Maffezzoni
       to incorporate the missing claim limitations of claims 1, 7, 13
       and 19 is insufficient.</u>

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the

patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Midgley does not teach storing backup files in a locked partition of a storage device, as recited in claim 1 and similarly in claims 7, 13 and 19. Office Action (5/3/2006), page 3. The Examiner further admits that Midgley does not teach running a virus scan on files determined to be modified, as recited in claim 1 and similarly in claims 7, 13 and 19. Office Action (5/3/2006), page 3. The Examiner further admits that Midgley does not teach uncorrupting modified files containing a virus that can be uncorrupted as recited in claim 1 and similarly in claims 7, 13 and 19. The Examiner modifies Midgley with Maffezzoni to include the above-cited claim limitations "in order to prevent copying of infected files and prevent their access to protect the user from inadvertent deletion or alteration of files." Office Action (5/3/2006), pages 4 and 8. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 1-19.

The Examiner has not provided a source for his motivation for modifying Midgley to include the above-cited claim limitations. The Examiner simply states "in order to prevent copying of infected files and prevent their access to protect the user from inadvertent deletion or alteration of files" as motivation for modifying Midgley to include the above-cited claim limitations. The motivation to modify Midgley must

come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-48 (Fed. Cir. 1998). The Examiner has not provided any evidence that his motivation comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 1-19. *Id.*

Further, the Examiner's motivation ("in order to prevent copying of infected files and prevent their access to protect the user from inadvertent deletion or alteration of files") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Midgley to include the missing claim limitations of claims 1, 7, 13 and 19. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-19. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Midgley addresses the problem of having to reinstall all the data previously stored on the tape instead of restoring just the portion of data that was lost. Column 1, line 63 – column 2, line 5. The Examiner has not provided any reasons as to why one skilled in the art would modify Midgley, which teaches reinstalling only the portion of the data that was lost, to store backup files in a <u>locked partition of a storage device</u>; to run a virus scan on files determined to be modified; and to uncorrupt modified files containing a virus that can be uncorrupted (missing claim limitations of Midgley). The Examiner's motivation ("in order to prevent copying of infected files and prevent their access to protect the user from inadvertent deletion or alteration of files") does not provide such reasoning. Hence, the Examiner's motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Midgley to include the missing claim limitations of claims 1, 7, 13 and 19. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-19. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Further, the Examiner's motivation ("in order to prevent copying of infected files and prevent their access to protect the user from inadvertent deletion or alteration of files") appears to have been gleaned only from Applicants' disclosure, such as for example on page 1, lines 8-25 of Applicants' Specification. Any judgment on obviousness must not include knowledge gleaned only from Applicants' disclosure. *In re McLaughlin*, 170 U.S.P.Q. 209, 212 (C.C.P.A. 1971). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 1-19. M.P.E.P. §2145.

    3.   <u>Examiner's motivation for modifying Midgley with Maffezzoni to incorporate the missing claim limitations of claims 2, 8 and 14 is insufficient.</u>

As stated above, in order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Midgley does not teach restoring files of the system with the backup files in the <u>locked partition of a storage device</u>, as recited in claim 2 and similarly in claims 8 and 14. Office Action (5/3/2006), page 4. The Examiner modifies Midgley with Maffezzoni to include the above-cited claim limitation "in order to protect the user from inadvertent deletion or alteration of files." Office Action (5/3/2006), pages 5 and 6. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 2, 8 and 14.

The Examiner has not provided a source for his motivation for modifying Midgley to include the above-cited claim limitation. The Examiner simply states "in

order to protect the user from inadvertent deletion or alteration of files" as motivation for modifying Midgley to include the above-cited claim limitations. The motivation to modify Midgley must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-48 (Fed. Cir. 1998). The Examiner has not provided any evidence that his motivation comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 2, 8 and 14. *Id.*

Further, the Examiner's motivation ("in order to protect the user from inadvertent deletion or alteration of files") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Midgley to include the missing claim limitations of claims 2, 8 and 14. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 2, 8 and 14. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

As stated above, Midgley addresses the problem of having to reinstall all the data previously stored on the tape instead of restoring just the portion of data that was lost. Column 1, line 63 – column 2, line 5. The Examiner has not provided any reasons as to why one skilled in the art would modify Midgley, which teaches reinstalling only the portion of the data that was lost, to restore files of the system with the backup files in the <u>locked partition of a storage device</u> (missing claim limitation of Midgley). The Examiner's motivation ("in order to protect the user from inadvertent deletion or alteration of files") does not provide such reasoning. Hence, the Examiner's motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Midgley to include the missing claim limitations of claims 2, 8 and 14. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 2, 8 and 14. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

B.   Claims 3, 9 and 15 are improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Midgley in view of Maffezzoni and in further view of Bucher.

The Examiner has further rejected claims 3, 9 and 15 under 35 U.S.C. §103(a) as being unpatentable over Midgley in view of Maffezzoni and in further view of Bucher (U.S. Publication No. 2005/0055559). Applicants respectfully traverse and respectfully request the Examiner to reconsider and withdraw these rejections.

As stated above, in order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Midgley and Maffezzoni do not teach destroying modified files containing a virus that cannot be uncorrupted, as recited in claim 3 and similarly in claims 9 and 15. Office Action (5/3/2006), page 9. The Examiner modifies Midgley and Maffezzoni with Bucher to include the above-cited claim limitation "in order to eliminate the corrupted data and eliminating any copy of the virus in the storage device, thereby preventing further propagation of the virus in the network." Office Action (5/3/2006), page 9. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 3, 9 and 15.

The Examiner's motivation ("in order to eliminate the corrupted data and eliminating any copy of the virus in the storage device, thereby preventing further propagation of the virus in the network") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the

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inventor and with no knowledge of the claimed invention, would modify Midgley to include the missing claim limitations of claims 3, 9 and 15. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 3, 9 and 15. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

As stated above, Midgley addresses the problem of having to reinstall all the data previously stored on the tape instead of restoring just the portion of data that was lost. Column 1, line 63 – column 2, line 5. The Examiner has not provided any reasons as to why one skilled in the art would modify Midgley, which teaches reinstalling only the portion of the data that was lost, to destroy modified files containing a virus that cannot be uncorrupted (missing claim limitation of Midgley). The Examiner's motivation ("in order to eliminate the corrupted data and eliminating any copy of the virus in the storage device, thereby preventing further propagation of the virus in the network") does not provide such reasoning. That is, the Examiner has not provided any rationale connection between Midgley, whose goal is to only reinstall a portion of the data that was lost, with the Examiner's motivation of eliminating corrupted data as well as eliminating any copy of the virus in the storage device. Hence, the Examiner's motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Midgley to include the missing claim limitations of claims 3, 9 and 15. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 3, 9 and 15. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

C.   Claims 4, 5, 10, 11, 16 and 17 are improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Midgley in view of Maffezzoni and in further view of Pak.

The Examiner has further rejected claims 4, 5, 10, 11, 16 and 17 under 35 U.S.C. §103(a) as being unpatentable over Midgley in view of Maffezzoni and in further view of Pak et al. (U.S. Publication No. 2003/0033536) (hereinafter "Pak"). Applicants respectfully traverse and respectfully request the Examiner to reconsider and withdraw these rejections.

1.   Midgley, Maffezzoni and Pak, taken singly or in combination, do not teach or suggest the following claim limitations.

Regarding claims 4, 10 and 16, Applicants respectfully assert that Midgley, Maffezzoni and Pak, taken singly or in combination, do not teach or suggest "downloading an updated virus template into said locked partition of said storage device if a virus template needed to be updated." The Examiner cites paragraph [0064] of Pak as teaching the above-cited claim limitation. Office Action (5/3/2006), page 11. Applicants respectfully traverse and assert that Pak instead teaches that the computer virus data files must be periodically updated with new computer virus definitions and code to enable the anti-virus engine to continue to provide up-to-data anti-virus protection. [0064]. While Pak teaches updating computer virus data files, there is no language in the cited passage that teaches downloading an updated virus template into a locked partition of the storage device. Further, there is no language in the cited passage that teaches downloading an updated virus template into a locked partition of the storage device if a virus template needed to be updated. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 4, 10 and 16, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

With respect to the above-cited claim limitation, if the Examiner is asserting that Pak teaches all of the above-cited claim limitations except the aspect of a locked partition of the storage device, then the Examiner needs to clearly indicate that fact as well as provide motivation for modifying both Midgley and Maffezzoni to download an updated virus template into the locked partition of the storage device.

Regarding claims 5, 10 and 17, Applicants respectfully assert that Midgley, Maffezzoni and Pak, taken singly or in combination, do not teach or suggest "copying modified files with no detected viruses; and copying modified files with a detected virus but cleaned by said virus scan." The Examiner cites column 15, lines 15-30 of Midgley as teaching copying modified files with no detected viruses. Office Action (5/3/2006), page 11. The Examiner further cites paragraph [0066] of Pak as teaching

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"with a detected virus but cleaned by the virus scan[1]." Office Action (5/3/2006), page 11. Applicants respectfully traverse.

Midgley instead teaches a synchronization replication process that replicates selected source data files data stored on the network to create a corresponding set of replicated data files, called the target data files, that are stored on a back up server. Column 2, lines 15-19. Midgley further teaches that the synchronization replication process builds a baseline data structure of target data files. Column 2, lines 19-20. Midgley further teaches that in parallel to this synchronization process, the system includes a dynamic replication process that includes a plurality of agents, each of which monitors file access operations for a server on the network to detect and capture, at the byte-level, changes to the source data files. Column 2, lines 20-25. Midgley further teaches that each agent may record the changes to a respective journal file, and as the dynamic replication process detects that the journal files contain data, the journal files are transferred or copied to the back up server so that the captured changes can be written to the appropriate ones of the target data files. Column 2, lines 25-30. Hence, Midgley teaches using agents to monitor changes to the source data files and to record such changes to a journal file. There is no language in the cited passage that teaches copying modified files with no detected viruses. Neither is there any language in the cited passage that teaches copying modified files. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 5, 11 and 17, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Further, Pak instead teaches scanning and cleaning files and attachments stored in the client storage. [0066]. While Pak teaches scanning and cleaning files, there is no language in the cited passage that teaches "with a detected virus but

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[1] Applicants note that it makes little sense to subdivide the limitation of "copying modified files with a detected virus but cleaned by said virus scan" into the limitations of "modified files" and "with a detected virus but cleaned by said virus scan." The aspect of "with a detected virus" only makes sense by having it joined with the thought of "copying modified files." The modified files that are being copied are those with a detected virus.

cleaned by the virus scan" as asserted by the Examiner. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 5, 11 and 17, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

      2.   Examiner's motivation for modifying Midgley and Maffezzoni with Pak to incorporate the missing claim limitations of claims 4, 10 and 16 is insufficient.

As stated above, in order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Midgley and Maffezzoni do not teach downloading an updated virus template into the locked partition of the storage device if a virus template needed to be updated, as recited in claim 4 and similarly in claims 10 and 16. Office Action (5/3/2006), page 10. The Examiner modifies Midgley and Maffezzoni with Pak to include the above-cited claim limitation "in order to provide a flexible and extensible anti-virus solution and further detect new virus for protecting files." Office Action (5/3/2006), page 11. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 4, 10 and 16.

The Examiner has not provided a source for his motivation for modifying Midgley to include the above-cited claim limitation. The Examiner simply states "in order to provide a flexible and extensible anti-virus solution and further detect new virus for protecting files" as motivation for modifying Midgley to include the above-cited claim limitation. The motivation to modify Midgley must come from one of

three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-48 (Fed. Cir. 1998). The Examiner has not provided any evidence that his motivation comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 4, 10 and 16. *Id.*

Further, the Examiner's motivation ("in order to provide a flexible and extensible anti-virus solution and further detect new virus for protecting files") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Midgley to include the missing claim limitations of claims 4, 10 and 16. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 4, 10 and 16. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

As stated above, Midgley addresses the problem of having to reinstall all the data previously stored on the tape instead of restoring just the portion of data that was lost. Column 1, line 63 – column 2, line 5. The Examiner has not provided any reasons as to why one skilled in the art would modify Midgley, which teaches reinstalling only the portion of the data that was lost, to download an updated virus template into a locked partition of a storage device if a virus template needed to be updated (missing claim limitation of Midgley). The Examiner's motivation ("in order to provide a flexible and extensible anti-virus solution and further detect new virus for protecting files") does not provide such reasoning. That is, the Examiner has not provided any rationale connection between Midgley, whose goal is to only reinstall a portion of the data that was lost, with the Examiner's motivation of providing a flexible and extensible anti-virus solution and further detect new virus for protecting files. In other words, the Examiner has not provided a rational reason as to why one skilled in the art would modify Midgley, whose goal is to only reinstall a portion of the data that was lost, to include a locked partition of a storage device and further to download an updated virus template into the locked partition of the storage device if a

virus template needed to be updated. Hence, the Examiner's motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Midgley to include the missing claim limitations of claims 4, 10 and 16. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 4, 10 and 16. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

     3.   <u>Examiner's motivation for modifying Midgley and Maffezzoni with Pak to incorporate the missing claim limitations of claims 5, 11 and 17 is insufficient.</u>

As stated above, in order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Midgley and Maffezzoni do not teach copying modified files <u>with a detected virus but cleaned by the virus scan</u>, as recited in claim 5 and similarly in claims 11 and 17. Office Action (5/3/2006), page 11. The Examiner modifies Midgley and Maffezzoni with Pak to include the above-cited claim limitation "in order to protect files for future processing." Office Action (5/3/2006), page 12. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 5, 11 and 17.

The Examiner has not provided a source for his motivation for modifying Midgley to include the above-cited claim limitation. The Examiner simply states "in order to protect files for future processing" as motivation for modifying Midgley to include the above-cited claim limitation. The motivation to modify Midgley must

come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-48 (Fed. Cir. 1998). The Examiner has not provided any evidence that his motivation comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 5, 10 and 17. *Id.*

Further, the Examiner's motivation ("in order to protect files for future processing") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Midgley to include the missing claim limitations of claims 5, 11 and 17. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 5, 11 and 17. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

As stated above, Midgley addresses the problem of having to reinstall all the data previously stored on the tape instead of restoring just the portion of data that was lost. Column 1, line 63 – column 2, line 5. The Examiner has not provided any reasons as to why one skilled in the art would modify Midgley, which teaches reinstalling only the portion of the data that was lost, to copy modified files <u>with a detected virus but cleaned by the virus scan</u> (missing claim limitation of Midgley). The Examiner's motivation ("in order to protect files for future processing") does not provide such reasoning. That is, the Examiner has not provided any rationale connection between Midgley, whose goal is to only reinstall a portion of the data that was lost, with the Examiner's motivation of protecting files for future processing. In other words, the Examiner has not provided a rational reason as to why one skilled in the art would modify Midgley, whose goal is to only reinstall a portion of the data that was lost, to copy files with a detected virus but cleaned by the virus scan. Hence, the Examiner's motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Midgley to include the missing claim limitations of claims 5, 11 and 17. Accordingly, the Examiner has not presented a *prima facie* case

of obviousness for rejecting claims 5, 11 and 17. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

D.   Claims 6, 12 and 18 are improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Midgley in view of Maffezzoni and Pak and in further view of Bucher.

The Examiner has further rejected claims 6, 12 and 18 under 35 U.S.C. §103(a) as being unpatentable over Midgley in view of Maffezzoni and in further view of Pak and in further view of Bucher. Applicants respectfully traverse and respectfully request the Examiner to reconsider and withdraw these rejections.

1.   Midgley, Maffezzoni, Pak and Bucher, taken singly or in combination, do not teach or suggest the following claim limitations.

Regarding claims 6, 12 and 18, Applicants respectfully assert that Midgley, Maffezzoni, Pak and Bucher, taken singly or in combination, do not teach or suggest "running said virus scan on files to be backed up prior to storing said backup files in said locked partition of said storage device; and uncorrupting said files to be backed up containing a virus that can be uncorrupted prior to storing said backup files in said locked partition of said storage device; wherein said backup files that are stored in said locked partition of said storage device are said files to be backed up with no detected virus and said files to be backed up with a detected virus but cleaned by said virus scan." The Examiner states:

> Maffezzoni teaches copying locked system files from a first drive of a computer system to a second drive (col. 3, lines 20-23). Pak teaches the anti-virus engine 17 scans and cleans files and attachments stored in the client storage 15 (paragraph [0066], lines 9-10). Bucher teaches a copy of data is sent to a network appliance, which analyzes whether it contains a virus (paragraph [0009]). Office Action (5/3/2006), page 14.

Applicants respectfully traverse. Applicants respectfully request the Examiner to particularly point out which limitations of the above-cited claim limitations are allegedly taught in the passages cited by the Examiner pursuant to 37 C.F.R. §1.104(c)(2). For example, which passage in which reference allegedly teaches "running the virus scan on files to be backed up prior to storing the backup files in the locked partition of the storage device." The Examiner does not appear to

address this limitation or the other limitations in claims 6, 12 and 18. Instead, the Examiner cites to the teaching of aspects that are not stated in the above-cited claim limitations. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 6, 12 and 18, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

    2. Examiner's motivation for modifying Midgley to incorporate the missing claim limitations of claims 6, 12 and 18 is insufficient.

   As stated above, in order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

   The Examiner admits that Midgley does not teach the limitations of claims 6, 12 and 18. Office Action (5/3/2006), pages 13-14. As understood by Applicants, the Examiner cites to passages in Maffezzoni, Pak and Bucher as teaching different aspects of claims 6, 12 and 18. Applicants respectfully request the Examiner to particularly point out which limitations in claims 6, 12 and 18 are taught by which reference pursuant to 37 C.F.R. §1.104(c)(2). Further, the Examiner needs to provide separate motivation for each modification to Midgley provided by a different reference. For example, the Examiner needs to provide a motivation for modifying Midgley with Maffezzoni to include a first limitation. The Examiner needs to provide another motivation for modifying Midgley with Pak to include a second limitation and so forth. Instead, the Examiner simply states that all these

modifications to Midgley by all these references are obvious to one of ordinary skill in the art "in order to eliminate the corrupted data and eliminating any copy of the virus in the storage device, thereby preventing further propagation of the virus in the network and further to prevent copying of infected files and prevent their access to protect the user from inadvertent deletion or alteration of files." Office Action (5/3/2006), page 14. This is insufficient.

Further, the Examiner has not provided a source for his motivation for modifying Midgley to include the above-cited claim limitations. The motivation to modify Midgley must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-48 (Fed. Cir. 1998). The Examiner has not provided any evidence that his motivation comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 6, 12 and 18. *Id.*

II.   <u>CONCLUSION</u>:

As a result of the foregoing, it is asserted by Applicants that claims 1-19 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims.   Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Applicants

By:

Robert A. Voigt, Jr.
Reg. No. 47,159

P.O. Box 50784
Dallas, TX 75201
(512) 370-2832

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